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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,522	06/30/2000	Hideo Ukuda	35.C14598	9628

5514 7590 06/13/2003

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EXAMINER

CAIN, EDWARD J

ART UNIT	PAPER NUMBER
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1714

10

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/606,522

Applicant(s)

UKUOA

Examiner

Edward Can

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-43 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 32-43 is/are allowed.
- ☒ Claim(s) 1, 2, 10-12, 17, 18 and 27-31 is/are rejected.
- ☒ Claim(s) 3-9, 13-16 and 19-26 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6, 7 and 9
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1714

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1, 2, 10, 11, 12, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 10, 11 and 17 recite a mathematical relationship between n_d and Abbe number. It is not clear whether the variables refer to the properties of the individual components or the properties of the composition.

Claims 2, 12 and 18 recite Abbe numbers outside the range of the claim from which they depend.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- 4.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 2, 10, 27, 28, 29, 30 and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by WO '108.

WO '108 discloses composition for the production of optical elements and systems. The composition of examples J and L on page 18 satisfies the n_d and Abbe number requirements of the instant claim.

Art Unit: 1714

6. Claims 3-9, 13-16 and 19-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 32-43 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cain whose telephone number is (703) 308-0042. The examiner can normally be reached on Monday-Friday 10:00 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9311 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

E. Cain/dh
June 4, 2003

A handwritten signature in black ink, appearing to be 'E. Cain', written in a cursive style.

Re: 09/606,522

1) With respect to the 102 rej, it is agreed that claim 1 at least is not anticipated by the WO reference. Note that US 6,229,654 is the US equivalent of WO. Comparative Exs J to L at cols. 11-12 in US '654 show that the Abbe number of a second material is e.g. 30 for polystyrene and is thus outside the scope of claim 1.

However, note that claim 2 (which improperly limits the scope of claim 1 i.e. a 112, 4th para problem) recites an Abbe of <40 which is met by the Abbe of 30 for polystyrene in Comparative Exs J to L cited above.

2) With respect to the inadequacy of the Search due to the absence of any search notes, classification searched, etc that conclusion is correct.

Upon its return, a supplemental action will be done.

Vasu Jagannathan
1714

9/3/03